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EXAMINER
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GRAY, JILL M

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/614,114  
Filing Date: July 07, 2003  
Appellant(s): LEVY, RICHARD

**MAILED**  
**MAY 17 2007**  
**GROUP 1700**

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Robert J. Eichelburg  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed January 10, 2007 appealing from the  
Office action mailed August 29, 2006.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

No amendment after final has been filed.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. In particular, Grounds (a) and (b) are treated together under one section. Grounds (c) pertaining to claims 73 and 76 are withdrawn by the examiner upon further consideration.

**(7) Claims Appendix**

A substantially correct copy of appealed claim 91 appears on page 23 of the Appendix to the appellant's brief. The errors are as follows: The phrase "surface comprises;" is missing. This is noted by the examiner because claim 91

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is the source of a 112 second paragraph rejection that is based upon this language. Following is a correct copy of claim 91:

91: The substrate of one of claims 57 or 65 wherein said:

(1) lubricating metal and alloy thereof, lubricating metal chalcogenide halide, carbonate, silicate or phosphate, or a particulate lubricating metal nitride, or a carbon lubricant; surface comprises;

molybdenum disulfide, cobalt chloride, antimony oxide, niobium selenide, tungsten disulfide, boron nitride, silver sulfate, cadmium chloride, cadmium iodide, cadmium oxide, borax, basic white lead, lead carbonate, lead monoxide, lead iodide, asbestos, talc, mica, zinc oxide, zinc phosphate, iron phosphate, manganese phosphate, carbon, graphite, babbitt, bronze, brass, aluminum, gallium, indium, thallium, thorium, copper, silver, gold, mercury, lead, tin, indium, or the Group VIII noble metals or mixtures thereof.

**(8) Evidence Relied Upon**

5,218,011	FREEMAN	6-1993
4,621,169	PETINELLI et al.	11-1986
5,049,593	MARCIANO- AGOSTINELLI et al.	9-1991

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 112***

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 57, 65, and 91 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

More specifically, claims 57 and 65 are vague and indefinite because it is not clear what the materials for lubricating a surface can be. In particular, the claim sets forth that the material for lubricating the surface comprises the components of (1) or the components of (2), however, it is not clear if the optional components of (3) are in addition to either (1) or (2), e.g. (1) and (3) or (2) and (3) or, alternative to (1) or (2), e.g., the lubricant comprises (1) or (2) or (3).

Also, it is not clear if the materials for lubricating the surface set forth in (1) comprises lubricating metal, and lubricating metal alloy, and lubricating metal chalcogenide and halide and carbonate, all of these components combined together, with a silicate or phosphate, or if each of the aforementioned components are alternatives. In addition, the term "phosphate" of (1) is broad and encompasses all phosphates, including the "organic phosphate" of (2). Hence, this language sets forth duplicate subject matter. Accordingly, each of the aforementioned concerns renders (4) which sets forth "mixtures thereof" indefinite.

Therefore, the metes and bounds for which patent protection is being sought are not clear.

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Claim 91 is indefinite for the reasons stated above and because the language of "wherein said: (1) lubricating metal and alloy thereof, lubricating metal chalcogenide halide, carbonate, silicate or phosphate, or a particulate lubricating metal nitride, or a carbon lubricant;" is an incomplete statement. Line 4, which sets forth "surface comprises;" is also an incomplete statement. And, the last paragraph of this claim is an incomplete statement. It is not clear how each statement of this claim relates to the other and the structural relationship is not clearly defined. It is not clear what the "surface" refers to, or if any of the components recited in the claim constitutes the "surface." Applicants' punctuation also appears to render this claim indefinite.

Therefore, the metes and bounds for which patent protection is being sought are not clear.

For the record, the examiner has interpreted the material for lubricating a surface of claims 57 and 65 as being either one of the components of (1) or one of the components of (2) or one of the optional components of (3) or mixtures thereof (4).

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 57-63, 65-71, and 87-90 are rejected under 35 U.S.C. 102(b) as being anticipated by Freeman 5,218,011.

Freeman teaches a substrate coated with an essentially water-free composition and method for protecting a substrate such as wires and cable from the affects of water or water migration (claims 62-63, 70-71, and 89-90), wherein the composition comprises a gel matrix, thickener and water absorbent polymer dispersed therein, per claims 57 and 65. The gel matrix can be an organic lubricant such as a petroleum or synthetic lubricant (claims 58 and 66) or silicone or glycol or an organic ester (claims 61 and 69) and the thickener can be a silicate. See abstract and column 7, lines 19-39 and line 58 through column 8 and line 9. In addition, Freeman teaches that the superabsorbent polymer can be based on acrylamides, acrylates, and acrylonitriles, starch grafted copolymers, and FAVOR C96, a crosslinked polyacrylic acid, (claims 59-60 and 67-68) which are the same superabsorbent polymers disclosed by applicants as absorbing greater than 100 times its weight in water. Accordingly, the examiner has reason to believe that the superabsorbent polymer of the prior art has the requisite absorption amount. As to claims 87 and 88, it should be noted that these claims are product-by-process claims. "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process."

Therefore, the teachings of Freeman anticipate the invention as claimed in present claims 57-63, 65-71, and 87-90.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 57-63, 65-71, 73, 76, and 87-91 are rejected under 35 U.S.C. 103(a) as being unpatentable over Petinelli et al, 4,621,169 (Petinelli) in view of Freeman 5,218,011 and Marciano-Agostinelli et al, 5,049,593 (Marciano-Agostinelli).

Petinelli teaches a cable and wire substrate coated with an essentially water-free composition, wherein said composition comprises a metal or metal oxide of metal such as zinc, copper or aluminum, or carbon or graphite, as required by claims 57, 62-63, 65, 70-71, and 91. See column 3, lines 61-65. Petinelli also teaches that his composition has an organic lubricant of the type contemplated by applicant in claims 58, 61, 66, and 69. See column 3, lines 40-51. Also, Petinelli teaches that his composition protects from the affects of water or water migration, per claims 89-90. See abstract. Petinelli does not teach the inclusion of a superabsorbent polymer.

Freeman is as set forth above and teaches an essentially water-free gel composition and method for protecting a substrate such as wires and cable from



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damage by water, said gel composition comprising a gel matrix, thickener and water absorbent polymer dispersed therein, wherein the gel matrix can be silicones, petroleum gels, high viscosity esters (fatty oils), glycols, olefins, mineral oil and fluorocarbons, as required by claims 57-58, 61-63, 65-66, 69-71, and 89-90. See abstract and column 7, lines 19-39 and line 58 through column 8 and line 9. In addition, Freeman teaches that the superabsorbent polymer can be based on acrylamides, acrylates, acrylonitrile and crosslinked polyacrylic acid, as required by claims 58-59 and 67-69, which are the same superabsorbent polymers disclosed by applicants as absorbing greater than 100 times its weight in water. Accordingly, the examiner has reason to believe that the superabsorbent polymer of the prior art has the requisite absorption amount. Freeman teaches that his composition is used to protect components from water damage and prevents water from migrating inside the cable. Freeman additionally teaches that the presence of superabsorbent polymers provides a traveling effect wherein the polymer is activated and travels into interstitial spaces if water is present thereby causing a plugging effect, and providing effective blockage in confined spaces. See column 5, lines 1-14 and 6, lines 20-29. This teaching would have provided motivation to one of ordinary skill in the art at the time the invention was made to modify the teachings of Petinelli by including a superabsorbent polymer in his hydrophobic gel composition, with the reasonable expectation of success of forming a substrate coated with an essentially water-free composition, said composition comprising a superabsorbent polymer and a lubricating metal and alloy thereof, and optionally

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an organic lubricant, wherein said composition is particularly useful in confined spaces in his cable and provides a plugging effect that prevents further invasion of water. Accordingly, it would have been prima facie obvious to modify the composition of Petinelli by adding superabsorbent polymers for added protection from water damage in view of the teachings of Freeman.

Freeman is silent as to the particle size of his superabsorbent particles.

Marciano-Agostinelli teaches a water migration resisting filler comprising a polymeric compound and particles of a water swellable material that is applied to stranded wires of cable, said particles having a particle size of less than 200 microns, per claims 73 and 76. See abstract and column 5, lines 51-53. The particles are of the type contemplated by applicants in claims 59-60 and 67-68, such as acrylamide and acrylate and have a water absorbing capability of 100 times its weight in water, as required by applicants in claims 57 and 65. See column 5, lines 43-62. As to the specific water absorbing properties of the superabsorbent particles, Marciano-Agostinelli teaches particles of the same type contemplated by applicant and as taught by Freeman. The skilled artisan would reasonably presume that the same particles necessarily have the same properties in the absence of factual evidence to the contrary.

Though Freeman is silent as to the specific particle size of his particles, it is the examiner's position that changes in size are ordinarily not a matter of invention and that where the difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art

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device, the claimed device was not patentably distinct from the prior art device. In the instant case, the present claimed composition having superabsorbent particles of the requisite particle size would not perform differently than the prior art composition. In the alternative, Marciano-Agostinelli teaches the usage of superabsorbent particles having a particle size within the range contemplated by applicants.

As to claims 87 and 88, it should be noted that these claims are product-by-process claims. "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process."

Therefore, the combined teachings of Petinelli, Freeman, and Marciano-Agostinelli would have rendered obvious the invention as claimed in present claims 57-63, 65-71, 73, 76, and 87-91.

#### **(10) Response to Argument**

##### **The rejection under 35 U.S.C. 112, second paragraph**

Appellant argues that subparagraph (4) of claims 57 and 65 clearly include any combination of lubricants in subparagraph (1) or any combination of lubricants in subparagraph (2) and any lubricant or combination of lubricants of subparagraph (1) with any lubricant or combination of lubricants of subparagraph (2). All of the forgoing lubricants, singly or in combination as noted may also

include an "optional" component of the materials or combination of materials recited in subparagraph (3).

Appellants' arguments have been noted. However, in light of appellant's arguments which are contrary to the phrasing found in claims 57 and 65, the examiner has found the metes and bounds of said claims to be confusing. Accordingly, the examiner is interpreting the instant claims broadly for prior art purposes.

Appellant argues that the subparagraph in both claims 57 and 65 clearly defines the lubricant as a compound comprising a lubricating metal chalcogenide, lubricating metal halide, lubricating metal carbonate, lubricating metal silicate, and lubricating metal phosphate, further arguing that the punctuation of subparagraph (1) clearly shows this, especially the absence of a comma before the term "or" in the recitation of the various lubricating metal compounds, and by use of a comma to set out the next category of lubricants comprising a particulate lubricating metal nitride or carbon lubricant.

In this concern, it is the position of the examiner that the phrase "lubricating metal chalcogenide, halide, carbonate, silicate, or phosphate" is not necessarily the same as the phrase "lubricating metal chalcogenide, lubricating metal halide, lubricating metal carbonate, lubricating metal silicate, and lubricating metal phosphate" as now argued by appellants. Again, as set forth above, in light of appellant's arguments which are contrary to the phrasing found in subparagraph of claims 57 and 65, the examiner has found this limitation to be confusing and has interpreted it broadly for prior art purposes.

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Appellant argues that the "phosphate" of subparagraph (1) comprises a "lubricating metal phosphate" and not an "organic phosphate" recited in subparagraph (2).

As set forth previously, in light of appellant's arguments and the phrasing in the claim, the examiner has found this language to be confusing.

Appellant argues that as it relates to claim 91, subparagraph (1) describes a genus of lubricants as the subject followed by the verb "comprises," and continues with a recitation of species of lubricants as the object, which makes it a complete sentence, contrary to the position taken by the examiner, further arguing that line 4 of claim 91 does not include the phrase "surface comprises" as the examiner contends.

In this concern, attention is directed to page 8 of the amendment of September 16, 2005, which sets forth claim 91, as reproduced below by the examiner.

91: The substrate of one of claims 57 or 65 wherein said:

(1) lubricating metal and alloy thereof, lubricating metal

chalcogenide halide, carbonate, silicate or phosphate, or a particulate

lubricating metal nitride, or a carbon lubricant;

surface comprises;

molybdenum disulfide, cobalt chloride, antimony oxide, niobium selenide,

tungsten disulfide, boron nitride, silver sulfate, cadmium chloride, cadmium

iodide, cadmium oxide, borax, basic white lead, lead carbonate, lead monoxide,

lead iodide, asbestos, talc, mica, zinc oxide, zinc phosphate, iron phosphate,

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manganese phosphate, carbon, graphite, babbitt, bronze, brass, aluminum, gallium, indium, thallium, thorium, copper, silver, gold, mercury, lead, tin, indium, or the Group VIII noble metals or mixtures thereof.

No amendments to this claim have been filed. Accordingly, appellant's arguments regarding claim 91 are unpersuasive.

Appellant's arguments regarding claims 73 and 76 have been considered. The rejection of these claims under 35 U.S.C. 112 second paragraph has been withdrawn.

The rejection under 35 U.S.C. 102(b) based on Freeman

Appellant argues that Freeman does not disclose the water absorbency of the polymer he employs, appellant's polymer has to absorb at least 100 times its weight in water, but Freeman does not teach this water absorbency, further arguing that Freeman's water absorbency could only be about 40 or 50, but the skilled artisan can make no determination of what the patentee required by way of water absorbency since the reference doesn't say anything in this regard and that Freeman also does not show the particle size of appellant's superabsorbent polymer.

In this regard, Freeman teaches that the superabsorbent polymer can be based on acrylamides, acrylates, acrylonitriles, and starch grafted polymer, which are of the type contemplated by appellants. See column 6, lines 20-28.

Moreover, Freeman teaches that the superabsorbent polymer can be "FAVOR C96", a crosslinked polyacrylic acid (see column 10, lines 32-35 and Examples). This superabsorbent polymer is the same type of polymer disclosed by appellant

as being suitable and as absorbing greater than 100 time its weight in water. (Note page 24 of the specification). Accordingly, the examiner has reason to believe that the superabsorbent polymer of the prior art (Freeman) has the requisite absorption amount. Furthermore, appellant has provided no evidence to support the allegation that the water absorbency of Freeman could only be about 40 or 50. As to whether Freeman shows the particle size of appellant's superabsorbent polymer, claims 57-63, 65-71, and 87-90, to which this anticipation rejection pertains, do not require the size of the particles.

Appellant argues that Freeman does not teach or suggest appellant's organic or inorganic lubricants, but rather the organic compounds at column 7, lines 20 et seq., further arguing that appellant claims organic lubricants comprising a polyphenyl ether, biphenyl phenanthrene or phthalocyanine compound which Freeman does not teach or suggest and that appellant also claims inorganic lubricants, and that none of the material listed in Freeman comprises the inorganic lubricants claimed according to the present invention.

Appellant's arguments are noted. However, attention is directed back to the rejection under 35 U.S.C. 112. As set forth previously, the examiner has interpreted claims 57 and 65 to be either one of the components of (1) or one of the components of (2) or one of the components of (3), and has interpreted the claims broadly for prior art purposes. Therefore, it is the examiner's position that the lubricants taught by Freeman anticipate the instant claimed "lubricant comprising an organic lubricant, inorganic lubricant, or a lubricant additive" and it

is not clear on this record that appellant's claims are limited to inorganic lubricants.

The rejection under 35 U.S.C. 103(a)

Appellant argues that the references provide no motivation, suggestion or teaching for combining them under 35 U.S.C. 103(a) for the purpose of an obviousness rejection and in fact, the references taken together would lead a person of ordinary skill in the art away from applicants' invention. In particular, appellant argues that the examiner has combined the teachings in an attempt to include the inorganic materials of Petinelli with the superabsorbent polymer of Freeman. In addition, appellant argues that Petinelli avoids corrosion by employing a composition having a hydrophobic gel whereby the superabsorbent polymers of Freeman absorb water, which are diametrically opposed. Hence, appellants argue that the hydrophobic properties of Petinelli are diametrically opposed to the hydrophilic properties of Freeman and fail to provide any motivation, teaching, or suggestion to combine the teachings in a way leading to appellant's invention, on the contrary, they teach away from the invention.

Agreeably Petinelli teaches that he avoids corrosion by using a moisture proofing hydrophobic gel. However, Freeman also teaches that his composition is a gel matrix having powdered water absorbent polymer mixed therein, wherein the gel matrix is hydrophobic and provides a barrier to the entry of water. See abstract and column 7, lines 19-39 and line 58 through column 8 and line 9. Thus, Petinelli and Freeman are both drawn to the protection of wires and cables from damage by water. Both seek to address this concern through the



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incorporation of hydrophobic gel compositions in their cable constructions.

Freeman provides for added protection by adding a superabsorbent polymer that, when activated is able to migrate into the interstices of the cable construction to stop water migration. Accordingly, it is the examiner's position that the teachings of Petinelli and Freeman are not diametrically opposed, rather, are within the same field of endeavor and seek to address the same problem in the art in substantially similar manners. Furthermore, Freeman teaches that the gel matrix is hydrophobic and the addition of a hydrophilic substance is beneficial because the gel provides an initial barrier to the entry of water in the spaces and if water does enter the space, the water absorbent polymer in the gel is activated and the water is absorbed. See column 4, lines 15-17, 29-38 and line 66 through column 5, and line 20. Clearly this teaching would have provided direction to the skilled artisan for protecting the contents within a cable from water damage using a gel composition and a suggestion to one of ordinary skill in this art that a composition comprising a hydrophobic gel matrix having a (hydrophilic) water absorbent polymer added thereto would result in a composition beneficial to protecting said contents from water. Accordingly, at the time the invention was made, the teachings of Freeman would have provided motivation to the skilled artisan to modify the hydrophobic gel of Petinelli by adding a water absorbent polymer to said gel with the reasonable expectation of success of forming a gel composition that repels water and additionally, in the presence of water absorbs the water that is present thereby causing a plugging effect that prevents the further invasion of water.

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Appellant argues that Freeman does not teach the instant claimed water absorbency of at least 100 times its weight in water and that Freeman's water absorbency could be only about 40 or 50. Appellant further argue that Freeman does not show the particle size of appellant's superabsorbent polymer.

As set forth previously, it is the position of the examiner that Freeman teaches superabsorbent polymers of the type contemplated by appellant. Therefore, the examiner has reason to believe that the water absorbency of the prior art superabsorbent particles is within the instant claimed range. As to the water absorbency of Freeman being only about 40 or 50, there is no factual evidence on this record to substantiate this allegation.

Appellant argues that Marciano-Agostinelli teaches a composition consisting of a mixture of a superabsorbent polymer and a rubber, wherein appellant does not employ rubber as a lubricant and none of the references relied on by the examiner teach or suggest that rubber comprises a material for lubricating a surface. Appellant argues that to combine Freeman with Marciano-Agostinelli would result in a composition containing some of the organic materials of Freeman, a superabsorbent polymer, another superabsorbent polymer and rubber, further arguing that if the examiner makes the combination, she has to take the rubber of Marciano-Agostinelli as well and that appellant does not use rubber as a lubricant and therefore, Marciano-Agostinelli standing alone or in combination with Freeman does not make appellant's invention obvious.

Agreeably Marciano-Agostinelli teaches a mixture of a superabsorbent polymer and a rubber. However, Marciano-Agostinelli also teaches the inclusion

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of inorganic lubricants such as graphite and silicate in his composition. That being said, it is the position of the examiner that the teachings of Marciano-Agostinelli must be relied upon for all that they would have reasonably conveyed to one of ordinary skill in the art at the time the invention was made. Namely, that the incorporation of superabsorbent polymers in cable filling compounds to improve the resistance to ingress and movement of water in cables is known in the art. Marciano-Agostinelli is also relied upon for his teaching that superabsorbent polymers such as polyacrylates and polyacrylamides have a water absorbency within the instant claimed range, and that the usage of said particles having a particle size within the instant claimed particle size are known in the art. As to the argument that the examiner must include the rubber of Marciano-Agostinelli in any combination made by the examiner, the examiner disagrees. In particular, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference...Rather, the test is what the combined teachings of those references would have suggested to those of ordinary skill in the art. It is not necessary that the inventions of the references be physically combinable to render obvious the invention under review, and combining the teachings of references does not involve an ability to combine their specific structures. MPEP 2145.

Appellant argues that the prior art does not provide a teaching, suggestion, or motivation to use the rubber of Marciano-Agostinelli in a lubricating material and contains no evidence relevant to selecting and combining the references, especially where common experience teaches rubber has just the

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opposite properties of a lubricant, i.e. there is no reason to combine the references because the examiner has not shown that rubber acts as a lubricant; the prior art does not show or suggest the desirability of the combination or reasonable expectation of success when using rubber in a composition for lubricating a surface; and that some advantage or expected beneficial result would have been produced by using rubber in a composition for lubricating a surface.

In this regard and as set forth above, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference...Rather, the test is what the combined teachings of those references would have suggested to those of ordinary skill in the art. It is not necessary that the inventions of the references be physically combinable to render obvious the invention under review, and combining the teachings of references does not involve an ability to combine their specific structures. MPEP 2145.

Accordingly, the examiner's position remains that when considered as a whole, the combined teachings of Petinelli, Freeman and Marciano-Agostinelli would have rendered obvious the invention as claimed in the present claims.

**(11) Related Proceeding(s) Appendix**


No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,

Jill Gray

  
JILL GRAY  
PRIMARY EXAMINER

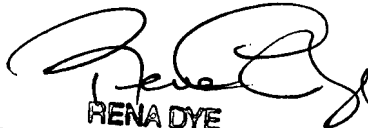
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